

Appl. No. 10/684,312

REMARKS

Applicant thanks the Examiner for the courtesy extended during a recent telephonic interview and for the Examiner's time and attention to the matters discussed. A summary of the interview is transmitted herewith as a separate letter.

As of this response, claims 17-27 are pending and no claims are herewith canceled, withdrawn or amended.

In the most recent Office Action, claims 17 through 27 were rejected as being anticipated by Christen (US 3,856,374). The remarks in the Office Action cited several reference numerals that either did not appear in the Christen '374 reference at all (14A, 14B, 30A, 30B, 28, 36), or that appeared to reference component types inconsistent with the remarks (34 being screws rather than 'flanges', 40 being a 'base' rather than a 'top side panel'). Furthermore, the remarks in the Action cited at least one passage (citing to '374, col 3, lines 30-49) that does not exist in the Christen reference. Consequently, the remarks in the recent Action do not effectively substantiate anticipation on the basis of the Christen reference. Furthermore, the remarks are so uninformative such that they contravene the requirements of 35 U.S.C. 132 and fail to articulate any usable information with which Applicant may clearly understand and fairly respond to the grounds of rejection. The Christen reference fails to anticipate and the remarks in the Office Action fail to meet the Office's burden in establishing anticipation.

Despite these issues, Applicant has nevertheless reviewed and considered the Christian reference in its entirety. Applicant notes that, as with the Slattery reference that was at issue during an earlier appeal, Christen lacks any variably constructed side that comports with Applicant's teachings or claims. Applicant holds that claims 17-27 are allowable over Christen.

In the recent Action, claim 17 was also rejected under 35 USC 112, 1st paragraph, as failing to comply with the written description requirement. The remarks allege that "the claims contain subject matter which was not described in the specification such a way as to recently conveyed to one skilled in the relevant art that the inventor, at the time

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the application was filed, had possession of the claimed invention. The recitation of the side designation having "user selectable variable construction" is not enabled by the specification to those skilled in the art. That recitation has no basis in the specification as to how a user would select a variable construction." During the recent interview, the Examiner confirmed that the concern centered on the 'user selectable' language.

As an initial matter, Applicant notes that the claims prior to the preliminary amendment dated 11/3/2008 included the language "...being selected by a user of the device...". This language was present throughout at least three Office Actions and through an Appeal that was decided around September of 2007. The Office never identified any inadequacy as to written description in connection with that previous language. To the contrary, the Office acknowledged the role of the user as supported in the as-filed specification and relied on this understanding in connection with various rejections.

In the course of trying to argue that analogous features were found within prior art references, the Office acknowledged the ability for a user to disassemble, store and then again employ a panel in a subsequent re-use of the device. The Examiners' Answer, dated 2/17/2006, on page 3 states:

"... with the selective configuration feature, considered disclosed in Bach, for the purpose of permitting panel removal and separate storage to affect the attribute of panel employment in forming a side."

Disassembly and reconstruction before each use, and especially the aspect of reconstructing in a different way to meet the needs of each use, is clearly the role of a user of the device.

On page 5 of the Examiner's Answer, the remarks continue with:

"...the configuration being selected by a user of the device to adjust and [sic] attribute of the enclosure when the device is in use for heating (again please see abstract where in the disclosed cover which may enclose other assembly parts is considered to expressly anticipate the user selected adjustments and attribute intended use)"

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Here the Office has likened the then-recited "configuration being selected by a user of the device" to "user selected adjustments and attribute intended use [sic]".

The Office also clearly acknowledged (Examiner's Answer, page 6), in Applicant's disclosure and claims, the need for user-variable configurations or constructions as follows:

"Since Slattery shows panels 22, 24, 26, 28 forming sides of a frame and the abstract discloses transverse ribs on end plates providing different grill levels and front and rear side plates fitting tightly into the end plates, this is considered to be broadly and reasonably construed to anticipate the argued feature because the different levels results in a variable configuration panels; i.e. side panels may configured with a low grill or high grill above a fire pan. This claim construction is considered consistent with appellants argued specification discussion in paragraph [0031] and figures 3-6."

Note that the Office voluntarily points to Figures 3-6 in support of its arguments. These are the among the areas of support that Applicant presently contends adequately fulfills the written description requirement for the limitation as to "user selectable".

In view of these earlier statements by the Examiner, it is wholly untenable for the Office to now take a position that the presently recited language of "user selectable" lacks any implicit, explicit or inherent support in the Application, especially from the perspective of one of ordinary skill in this art.

Indeed, the entirety of Applicant's teachings are in the context of a user assembling the unit in various ways in preparation for each use.

The Application, at paragraph 0015, sets forth that: "In preparing to use a heating/cooking unit according to the present teachings, a collapsible 'frame' is assembled or erected which functions to provide support of the items that are to be heated or cooked and to partially or fully enclose a heated space in various arrangements. This frame preferably comprises a number of side panel members which cooperatively engage one another to form the erect frame when needed."

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See also Application paragraph 0037 which reads as follows: "In accordance with the present teachings, any one side or combination of sides of such a frame or enclosure may be of variable arrangement, similar to what is shown as the front side of the enclosures of FIGS 3-5, to allow changing the height at which grill 108 (or other support member) is supported or to allow different portions of the side be selectively enclosed or left open as desired."

A user, according to a desired purpose for the unit upon each occasion of use, selects how to construct the unit accordingly as exemplified in Applicant's figures.

See paragraph 0038, which mentions the rearrangeability aspect as follows: "In an alternative embodiment shown in FIG 6, a single side of the frame to be formed of rearrangeable panels as described above..."

Also, from paragraph 0006: "The present invention provides for a single compact unit that, in various configurations, may be used in all of these capacities. Aside from adaptability for use in a wide variety of configurations, further improvements are realized in the degree of compactness and lightweightness and in ease of manufacture and use."

It is clear that, as enabled and described by Applicant's teachings, a single finished unit is freely adaptable into many configurations to meet the need at hand, that need being decided, and configuration implemented, by the user of the device.

Applicant draws attention to relevant portions of MPEP 2163 as follows:

"[T]he 'essential goal' of the description of the invention requirement is to clearly convey the information that an applicant has invented the subject matter which is claimed." *In re Barker*, 559 F.2d 588, 592 n.4, 194 USPQ 470, 473 n.4 (CCPA 1977). Another objective is to put the public in possession of what the applicant claims as the invention. See *Regents of the University of California v. Eli Lilly*, 119 F.3d 1559, 1566, 43 USPQ2d 1398, 1404 (Fed. Cir. 1997), *cert. denied*, 523 U.S. 1089 (1998).

Applicant's originally filed disclosure fully puts "the public in possession of what applicant claim as the invention" even with respect to the present claims.

It is not necessary for the exact language recited in the claims to be found *per se* in the specification. Reading again from MPEP 2163: "While there is no *in haec verba* requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure."

Applicant maintains that such support for the present claims is in the as-filed Application explicitly, implicitly and inherently as discussed further below and that support was pointed out by Applicant as part of the recent Preliminary Amendment filed by Applicant.

Continuing from MPEP 2163: "This disclosure may come in a variety of forms: "An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997)."

Applicant respectfully contends that, in view of Applicant's original disclosure (such as Figures 3-5 with the accompanying text), it would be readily evident to an average reader, much more so one of ordinary skill in this relatively simple and predictable art, that a user selects the desired configuration or construction according to instant need and how the ability of a user to select and implement differing configurations is made possible by Applicant's teachings. The burden is upon the Office to show otherwise and has failed to meet this burden.

Further, as to the issue of demonstrating possession as would be recognized by a person of ordinary skill in the art in view of the filed application, the Office has failed to mount any reasonable showing that a person of ordinary skill would view that the inventor did not consider that it would be a user assembling the unit who would select the configuration from among figures 3, 4 or 5, for example. Applicant maintains that the stance of the Office in the §112 rejection is without merit in view of such passages in Applicant's disclosure considered as a whole.

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Applicant's claims are commensurate in scope with the originally filed disclosure and/or have explicit, implicit or inherent support therein. Explicit support is found at least among paragraphs 0006, 0015 and 0037. Implicit support is evident at least at paragraphs 0006, 0015, 0031, 0037 and 0038. Finally, Applicant further points out the inherency of "user selectable" as the decision about which of many possible desired *ad hoc* configurations, and the assembly actions to achieve this in-use configuration, are the responsibility of the user. The "user selectable" aspect is necessarily present in the original disclosure and an entity, the user, must decide and enact one of many in-use configurations as typified in figures 3, 4 and 5. This is clearly supported by the as-filed Specification. The fact that Applicant also shows (as in Figs 14A, 14B) a disassembled unit and how to compact and stow a disassembled unit also reinforces that the unit is designed to be flexibly re-used and is not subject to a single, permanent construction. As clearly established by the specification, the whole of the teachings are directed to a unit that may be assembled in different ways under different circumstances and disassembled when not in use. Thus, the construction is variable throughout the lifetime of use of a given unit upon each occasion that it is used. Thus, each time it is constructed, a user selects how to construct it.

The remarks in the recent Action (page 2, 3rd and 6th sentences) seem draw into this argument the topic of 'enablement', which is a somewhat different matter. The remarks imply an even more far-fetched view that one of ordinary skill could not understand how to make and use the described invention (or recognize possession of same by Applicant) without having the exact words 'user-selectable' appear somewhere in the originally filed specification.

Whether the rejection is based on alleged lack of enablement or lack of written description, Applicant questions whether the Office is asking the Applicant to explain 'how' a user decides whether to grill or to bake a given item. Applicant has adequately depicted by several examples how, once that decision is made by a user, the available parts of the described invention are placed to accommodate the desired in-use configuration. Applicant is puzzled as to what, in the view of the Office, is left to

understand that would be beyond the understanding of one of ordinary skill in this well-established and predictable art.

In view of the points raised above, Applicant respectfully submits that the Office has failed to meet its burden in support of the rejection of claim 17 under 35 USC 112 and that this rejection is groundless when one considers Applicant's initial disclosure in its entirety. Applicant respectfully requests reconsideration of the rejection and allowance of claim 17 and all dependent claims in view of these arguments.

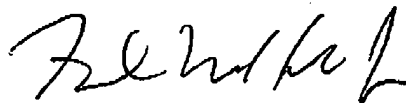
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CONCLUSION

Applicant respectfully requests that the Examiner reconsider the outstanding rejections and that they be withdrawn. Applicant believes that a full and complete response has been made to the recent Office Action, as such, the present application should be considered for allowance. If the Examiner believes for any reason that personal communication will expedite prosecution of this Application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of these remarks is respectfully requested.

Respectfully submitted,



Frank McKiel, Jr.

Reg. No. 43,792

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Correspondence address:
5880 Derby Rock Loop
Manitou Springs, CO 80829
(719) 685-4700